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09/774,117	01/31/2001	Paul Haverstock	52817.000159	1148

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PILLSBURY WINTHROP SHAW PITTMAN, LLP  
P.O. BOX 10500  
MCLEAN, VA 22102

EXAMINER

KANG, PAUL H

ART UNIT PAPER NUMBER

2141

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/774,117

**Applicant(s)**

HAVERSTOCK

**Examiner**

Paul H. Kang

**Art Unit**

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

1. Claims 1-20 have been cancelled. Claims 21-40 are now pending.

### *Double Patenting*

2. The applicant has deferred filing a terminal disclaimer until the claims are placed in condition for allowance. Applicant is reminded that a reply to an Office action **MUST BE FULLY RESPONSIVE** to the prior Office action. MPEP 714.02. In order to be fully responsive, applicant must address all pending rejections, including the double patenting rejection, and may not defer this issue. The double patenting rejection from the prior Office action is repeated below:

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 and 1-18 of U.S. Patent Nos. 6,064,977 and 6,301,621, respectively. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because the context of the present claimed invention is similar to that of the patented application.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higley, US Pat. No. 5,790,793 (herein referred to as Higley) in view of Sankar, US Pat. No. 5,867,822 (herein referred to as Sankar).

6. As to claims 21, 27, 33 and 39, Higley teaches the invention substantially as claimed. Higley teaches a server system providing integrated scheduling and calendaring capability comprising:

a server (Higley, col. 5, lines 1-53);

at least one database associated with the server (Higley, col. 5, lines 1-53);

a plurality of non-markup language objects stored in the at least one database (Higley teaches a server which contains a plurality of objects; col. 5, lines 1-53); and

wherein the server enables the user to select at least one non-markup language object from the plurality of non-markup language objects (a user may select a URL link to a non-

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markup language [text] message on the server; Higley, col. 5, lines 1-53), and based on the selection of the user, translates the selected non-markup language object to at least one markup language object (Once the user selects the URL, a non-HTML version of the message is translated into HTML and transmitted to the user; Higley, col. 5, line 54 – col. 6, line 8. See also figure 4, elements 440, 442 and 444).

However, Higley does not explicitly teach the non-markup language object comprising scheduling and calendaring information for at least one user. In the same field of endeavor, Sankar teaches a system for managing electronic calendars and events throughout an enterprise (Sankar, col. 4, line 1 – col. 5, line 8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the scheduling and calendaring system of Sankar into the system of Higley for the purpose of integrating legacy system by translating non-markup language objects to markup language versions.

7. As to claims 22, 28, 34 and 40, Higley-Sankar teaches the system wherein the at least one markup language object is displayed using a browser (Higley, col. 5, lines 1-53).

8. As to claims 23, 29 and 35, Higley-Sankar teaches the system wherein the server comprises a server module, an interface module comprising a markup language to non-markup language translator, and a non-markup language database server module (Higley, col. 5, lines 1-53).

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9. As to claims 24, 30 and 36, Higley-Sankar teaches the system wherein the server module comprises an HTTP server (Higley, col. 1, lines 8-35).

10. As to claims 25, 31 and 37, Higley-Sankar teaches the system wherein the server is operable to receive a URL based request for the at least one non-markup language object from a browser, and determine a location of the at least one non-markup language object (Higley, col. 2, line 14 – col. 3, line 34).

11. As to claims 26, 32 and 38, Higley-Sankar teaches the system further comprising a passing module that passes the at least one markup language object to a browser (Higley, col. 2, line 14 – col. 3, line 34 and col. 5, lines 1-53).

### ***Response to Arguments***

12. Applicant's arguments filed November 12, 2004 have been fully considered but they are not persuasive. The applicants argued in substance that:

“Higley does not provide the user with a plurality of documents and therefore does not enable a user to select documents to convert. Higley is therefore deficient because it doesn't enable the user to select at least one non-markup language object from the plurality of non-markup language objects, and based on the selection of the user, translates the selected non-markup language object to at least one markup language object.” See Applicant's Remarks of November 12, 2004 (pages 11-12).

See Applicant's Remarks of November 12, 2004 (pages 11-12).

The examiner respectfully disagrees with applicant's reading of the Higley reference.

Applicant seems to argue that because the in the exemplary embodiment Higley shows only one URL in an email message, the system of Higley does not teach “a plurality of non-markup language objects stored in the at least one database.” It also appears applicant is arguing because

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only one URL is shown in the exemplary email message, the system of Higley is capable of only displaying/providing to the user only one URL. This would be an unfairly narrow reading of Higley's teaching. Not only was it notoriously well known to the artisan of ordinary skill in the art the ability to provide multiple URLs on one email page, the disclosure Higley refers to "transmitting Uniform Resource Locators (URLs)" to the user, referencing URL in plural.

Further, even when adopting applicant's narrow interpretation of Higley, the invention as claimed does not require proving the user with a plurality of objects to choose from. Claim 21, for instance, states "wherein the server enables the user to select at least one non-markup language object from the plurality of non-markup language objects." When the claim is given the broadest reasonable interpretation consistent with the specification, this limitation merely requires the server enable a user to select the one URL to a single non-markup language object (the one URL sent to the user in the email) from the plurality non-markup language objects stored on the server. In other words, the invention as claimed does not preclude the interpretation "a database having stored thereon a plurality of non-markup language objects, and transmitting to the user one URL associated with one non-markup language object to enable the user to select the one non-markup language object."

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

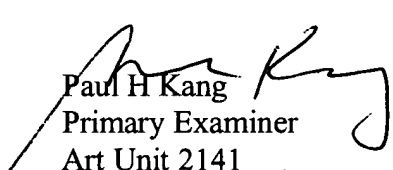
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (703) 308-6123. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Paul H Kang  
Primary Examiner  
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